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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/981,840

10/17/2001

Phillip W. Barth

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7590

05/21/2004

AGILENT TECHNOLOGIES, INC.

Legal Department, DL429

Intellectual Property Administration

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EXAMINER

NORRIS, JEREMY C

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,840

Applicant(s)

BARTH ET AL.

Examiner

Jeremy C. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-18 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1001, 1002, 0204.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, species i, in Paper Dated 23 February 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

The information disclosure statement filed 05 February 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 13, 14, 16-18, 27, 28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,641,400 (hereafter Kaltenbach).

Kaltenbach discloses, referring to figure 5A, a flexible circuit comprising: a substrate (62A) having a plane; a flexible and extensible structure (62B) formed within said substrate and co-planar with said substrate; and wherein said structure is adapted

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to be extended out of said plane by a distance greater than a maximum lateral dimension of said structure [claim 1], further comprising a pathway (36') formed on said structure [claims 2, 17], wherein said pathway is a capillary for transferring a fluid (see col. 13, lines 25-35) [claims 3, 18], wherein said structure has geometric features selected from a group comprising spiral, bend, curve, twist, turn, curl, loop, u-turn and zigzag (see figure 5A) [claims 13, 27], wherein said structure is defined by perforations (see col. 13, lines 1-5) [claims 14, 28], further comprising at least a first pathway and a second pathway (see col. 13, lines 25-35) [claims 16, 30].

Claims 1, 2, 15, 17, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,088,498 (hereafter Hibbs).

Hibbs discloses, referring to figure 1a, a flexible circuit comprising: a substrate (12) having a plane; a flexible and extensible structure (18) formed within said substrate and co-planar with said substrate; and wherein said structure is adapted to be extended out of said plane by a distance greater than a maximum lateral dimension of said structure [claim 1], further comprising a pathway (16) formed on said structure [claims 2, 17], wherein said structure comprises a boss (30) for receiving a force to extend said structure out of said plane [claims 15, 29].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-12 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach in view of US 5,186,238 (hereafter del Puerto).

Kaltenbach discloses the claimed invention as described above except Kaltenbach does not specifically state that the structure is a spiral, let alone the particular shape of said spiral. However, it is well known in the art to comprise cooling channels such as those disclosed by Kaltenbach in the shape of spirals including, but

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not limited to Archimedes' spirals parabolic spirals and square spirals, as evidenced by del Puerto (see figures 2 and 2A, and col. 4, lines 5-20). Therefore, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to form the cooling channels in the invention of Kaltenbach in the form of Archimedes' parabolic or square spirals as is well known in the art and evidenced by del Puerto. The motivation for doing so would have been to provide cooling channels with sufficient surface area and capillary action to effectively cool the adjoining structure (see del Puerto col. 4, lines 50-65). Moreover, it has been held that more than a mere change of form is necessary for patentability. *Span-Deck, Inc v. Fab-Con, Inc.* (CA 8, 1982) 215 USPQ 835.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,879,632, granted to Yamamoto et al., discloses a cooling circuit.

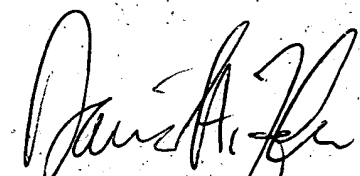
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 571-272-1932. The examiner can normally be reached on Monday - Friday, 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCSN


David H. Farneke
Primary Examiner
5/14/04